

Application Ser. No. 09/911,243
Response to Office Action Mailed June 1, 2004

REMARKS

In response to the office action dated June 1, 2004, main claims 17 and 21 have been amended to sharpen the claim language and express with greater clarity the structure and function of the device to clearly define over the cited references.

It is respectfully submitted that claims 17-26 are in condition for allowance in view of the following remarks which also embody the substance of the interview between Examiner Luk and the undersigned attorney on July 13, 2004.

I. **§ 103 Requires that the Invention be Considered
"As a Whole" and that Certain Factual
Requirements Must Be Made**

The Examiner has referred to Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), which states that factual inquiries should be applied as establishing a background for the determination of obviousness under § 103. Claims 17-26 are directed to a device for preventing breakage of a polymeric film or nonwoven web during stretching. The revised claims 17-26 require interdigital rollers having circumferential grooves for stretching a length of film or web along a plurality of lines across its width. A segment of the first roller grooves is adapted for receiving a substantially unstretched area of the film or web adjacent the lines along its length prior to the intersection of the grooves. In the case of main claim 17, at least one disc is provided for contacting the

Application Ser. No. 09/911,243
Response to Office Action Mailed June 1, 2004

unstretched area of the film prior to the intersection of the grooves and said disc also functions for pressing the film area into the segment of grooves of the first interdigital roller without substantially stretching the film. In the case of main claim 21, a controller is also provided for creating the substantially unstretched area in the film for receipt by the segment of grooves. Subsidiary claims 18-20 and 22-26 provide for other elements such as a set of interengaging spaced rollers for creating the slack or unstretched area of the film (claim 18), or a bar, folder, etc. (claims 19-20). Claims 22-26 provide for a plurality of controllers (claim 22), a presser or disc for pressing the slack or unstretched area into the first interdigital roller (claims 23-24), a member to create the slack in the film for different controllers (claim 25), and for laterally adjustable controllers (claim 26). All of the claim language is supported by the specification pages 9-14, and Figs. 1-9.

Against the factual background of claims, neither Kezuka nor the Wenning patent which have been cited against the claims disclose interdigital rollers which serve to stretch a film or web. In fact, both references are directed to molding corrugated extrusions of plastic material. Furthermore, neither of the patents discloses or suggests a mechanical element or controller which creates slack during stretching of a polymeric film or nonwoven web to prevent breakage. Moreover, main claims 17 and 21 require a segment of the first roller for receiving the slack or unstretched area of the film before the

Application Ser. No. 09/911,243
Response to Office Action Mailed June 1, 2004

intersection of the rollers. At least one disc is provided for contacting the unstretched film area prior to the intersection of rollers and for pressing the film area into the segment of grooves. In the case of claim 21, the additional mechanical element of the controller for creating the slack or unstretched area in the film is recited. There is no disclosure or suggestion in either the Kezuka or Wenning patents any of the claimed structural limitations which provide the function recited in the claims 17-26. The structure and functional language of main claims 17 and 21 patentably distinguish over the patents cited under 35 U.S.C. §103.

II. Authorities

It is applicant's position that the Patent Act of 1952 introduced a new statute with respect to "functional" claims in the last paragraph of 35 U.S.C. §112. As enunciated by the decision of the CCPA in In re Fuetterer, 138 USPQ 217 (1963):

I should like to say a word on the provision in the bill for functional claiming. [H.R. 3760, 82d Cong., 1st Sess., §112 (1951)]***. This provision in reality will give statutory sanction to combination claiming as it was understood before the Halliburton decision. All the elements of a combination now will be able to be claimed in terms of what they do as well as in terms of what they are. (Court's emphasis).

Inasmuch as it is our opinion (1) that there is no statutory ban on the use of the "functional" language employed in the instant claims by appellant; . . . (3) that the use of such functional statements as here

Application Ser. No. 09/911,243
Response to Office Action Mailed June 1, 2004

appear is specifically sanctioned by the third paragraph of 35 U.S.C. §112; . . .

The issue was also taken up by the Court of Customs and Patent Appeals in In re Attwood, 148 USPO 203 (CCPA 1966). The Court recognized that claimed "use limitations" or functions are "functional expressions which must be given weight". (In re Attwood, at 210). In view of the significance of the Court's language, it is reproduced as follows:

The Board's "Fully Structurally
Met" Idea

We refer to this as an idea rather than a rejection as it is not clear whether the board was making a new rejection or merely supporting the examiner's obviousness rejection by a sort of a fortiori argument, regarding a reference that fully meets a claim as the ultimate in showing obviousness. this idea was not applied to claim 51. As to the other claims, the board could reach its conclusion only by ignoring parts of the claim which do not, in fact, read on Holmstrom. These parts are in clauses (1) and (6) of our claim analysis, supra, namely, the parts beginning with the word "for." The board deemed these to be "use limitations" which merely denoted intended use, of no patentable significance, which cannot be relied on to sustain patentability. We do not so regard them. (Emphasis added)

. . . All this was prior to the Patent Act of 1952 which introduced a new statute with respect to "functional" claims in the last paragraph of 35 U.S.C. 112. One of the purposes of this statute was modification of the Halliburton rule. As stated in

Application Ser. No. 09/911,243
Response to Office Action Mailed June 1, 2004

Federico's Commentary on the New Patent Act, 35 U.S.C.A., at p. 25: (Emphasis added)

We have here a combination claim and the limitations ignored by the board as use limitations we think are functional expressions which must be given weight. We consider that 35 U.S.C. 112 has rendered much if not most of what was said in Dalton on this point obsolete. When these clauses are considered, there is no foundation for the board's view that the claims read on Holmstrom. (Emphasis added)

Further, we believe that the claim limitations to frame members for use in adjustable framing construction etc. should be given weight under our decision in *Kropa v. Robie*, 35 CCPA 858, 187 F.2d 150, 88 U.S.P.Q. 478, 481.

In addition to the above cases, more recently, the Court of Customs and Patent Appeals has decided In re Angstadt and Griffin, 190 USPQ 214 (CCPA 1976) and In re Geerdes, 180 USPQ 789 (CCPA 1974). In the In re Geerdes case, the Court pointed out that:

every limitation in the claim must be given effect rather than considering one in isolation from the others" (Court's emphasis), at page 791.

Similarly, the Court stated in In re Angstadt and Griffin at page 217:

We note at the outset that the claim limitation "to form *** hydroperoxides" must be given effect since we must give effect to all claim limitations. See *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789

Application Ser. No. 09/911,243
Response to Office Action Mailed June 1, 2004

(CCPA 1974); *In re Wilder*, 57 CCPA 1314, 429 F.2d 447, 166 USPQ 545 (1970). Furthermore, the use of functional language is sanctioned specifically by the third paragraph of section 112. (Court's emphasis)

More recently, in *Wentworth v. Schena*, 219 USPQ 1042, 1044 (Patent and Trademark Office, Board of Patent Interferences 1983) when the Board was confronted with an apparatus claim containing the language "for supplying catalyst to a blower of a liquid fuel combustion device", it held that such a functional recitation must not be ignored citing *Kropa v. Robie*, 187 F.2d 150, 88 USPQ 478 (CCPA 1951); *In re Attwood*, 354 F.2d 365, 148 USPQ 203 (CCPA 1966); *Ex parte Varga*, 189 USPQ 204 (Pat.Bd.App. 1973).

As developed during the course of the interview with Examiner Luk, the structure and functional language of the claims must be considered in evaluating the patentability under 35 U.S.C. §103.

III. Conclusion

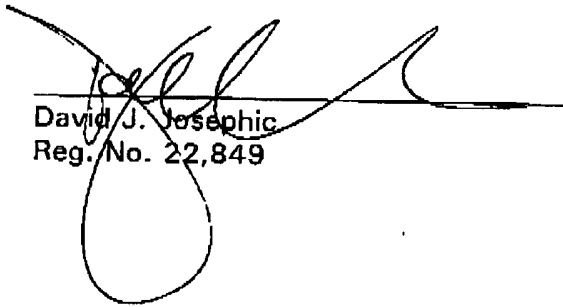
It is respectfully submitted that neither of the *Kezuka* or *Wenning* patents alone or in combination disclose or render obvious the essential elements and their function as recited in claims 17-26. In view of the above authorities and reasons advanced, claims 17-26 are patentable and their

Application Ser. No. 09/911,243
Response to Office Action Mailed June 1, 2004

allowance is respectfully solicited. If any issue remains, the Examiner is encouraged to phone the undersigned.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.



David J. Josephic
Reg. No. 22,849

2700 Carew Tower
441 Vine Street
Cincinnati OH 45202
(513)241-2324